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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,474	07/19/2001	John F. Boylan	01017/36524A	7250

4743 7590 10/07/2003

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EXAMINER	
MONSHIPOURI, MARYAM	

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,474	BOYLAN ET AL.	
	Examin r	Art Unit	
	Maryam Monshipouri	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-76* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, 10-11, 53-55, 68-69, and 75-76, drawn to isolated DNA molecules encoding a human serine/threonine kinase (h2520-59), vectors and host cells comprising said molecules, methods of expressing said molecules, compositions comprising said molecules, classified in class 435, subclass 194.

II. Claims 9, 14-24, 47-52 and 56-57, drawn to said kinase , compositions comprising said kinase, fusion products of said kinase , classified in class 435, subclass 194.

III. Claims 25-40, 45-46 are drawn to antibodies which specifically bind said kinase and methods of use of said antibodies, classified in class 435, subclass 7.1.

IV. Claims 30, 41-43 drawn to modulators of said polypeptides, classification unknown. This because classification is based on chemical structure of modulators and applicant has not defined the chemical structure of said modulators.

V. Claims 12-13, 65, 44 and 58-60, drawn to methods of using said modulators, classified in class 514, subclass 789.

VI. Claim 61, drawn to methods of treatment using said kinase, classified in class 424, subclass 94.5.

VII. Claim 62, drawn to methods of diagnosing a disease caused by said kinase using said DNA molecules, classified in class 435, subclass 6.

VIII. Claims 63-64, drawn to devices comprising encapsulated cells comprising said kinase, classified in class 424, subclass 450 .

IX. Claim 66, drawn to methods of modulating said kinase, classified in class 435, subclass 15.

X. Claim 67, drawn to transgenic non-human animal comprising said DNA molecules, classified in class 800, subclass 13.

XI. Claims 70-73, drawn to hybridization assays using said DNA molecules, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The DNA of Group I, the kinase of Group II, the antibodies of Group III, the modulators of Group IV, the device of Group VIII and the transgenic animal of Group X are patentably distinct each from the other because each product has an unrelated structure and function.

Inventions I and VII (or XI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group I may be used in recombinant preparation of said kinase which is a totally different method than any of those of Groups VII and XI.

The DNA of Group I is unrelated to any of the methods of Groups V, VI, and IX because said product is neither made nor used by any of said methods.

Inventions II and VI (or IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the kinase of Group II may be used for antibody preparation which is a totally different method than any of those of Groups VI and IX.

The kinase of Group II is unrelated to any of the methods of Groups V, VII, and XI because said product is neither made not used by any of said methods.

Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the modulators of Group IV may be used for modulating said kinase in vitro which is a totally different method than that of Group V.

The modulators of Group IV are unrelated to any of the methods of Groups VI, VII, IX and XI because said product is neither made nor used by any of said methods.

The device of Group VIII and the transgenic animal of Group XI are unrelated to any of the following methods : Group V, VI, VII. IX and XI. This is because said products are neither made nor used by any of said methods.

The methods of Groups V, VI, VII, IX or XI are patentably distinct each from the other because each method has different steps and different end-points.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri Ph.D. whose telephone number is (703) 308-1083. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Dr. P. Achutamurthy, can be reached at (703) 308-3804.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

M. Monshi

MARYAM MONSHIPOURI, PH.D.
PRIMARY EXAMINER